

REMARKS/ARGUMENT

Claims 1-19 are pending in the present application. Claims 1-11 and 15-17 are amended herein. Claims 18 and 19 are new.

Independent claims 1, 5 and 11 are amended herein to recite *inter alia* that (i) at least a portion of the second display elements have a different shape than the first display elements, (ii) the first display elements and the second display elements comprise external decorative shell elements, (iii) the first display elements and the second display elements substantially enclose the front and sides of the top box, and/or (iv) at least a portion of the first display elements and the second display elements include a side panel for the top box display.

Independent claim 17 is amended herein to recite *inter alia* that (i) at least a portion of the display elements between the first and second games have different shapes, (ii) the display elements comprising external decorative shell elements for the top box, and (iii) at least a portion of the display elements including side panels for the top box.

New claims 18 and 19 recite *inter alia* that at least a portion of the standardized substructure is situated toward the back of the top box.

Support for the claim amendments and new claims can be found, for example, in FIGs. 3-8 and in ¶¶ [0025], [0031] and [0034] of the present application as published in U.S. Patent Application Publication No. US 2005/0054449. No new matter has been added.

Additional discussion of the currently pending claims are provided below. Reconsideration and allowance are respectfully requested in view of the following remarks.

Telephonic Interview and Interview Summary

The Applicants note with appreciation the interview with Examiners Hotaling and Torimiro on October 4, 2007. The Applicants have amended claims 1-11 and 15-17 to clarify the invention.

During the interview, the Examiners disclosed a new reference, U.S. Patent No. 6,135,884 (“Hedrick”), as describing a gaming machine having a top box. The Applicants then pointed out the differences between prior art cited in the Office action, U.S. patent documents 4,440,457 (“Fogelman”) and 2004/0051249 (“Seelig”), and the claimed invention. Specifically, Applicants discussed the references’ lack of disclosure of the second display elements being different than the first display elements, as recited, for example in amended claim 1. The Examiners indicated that they would consider such amendments in furthering the prosecution of the present application.

Objection to the Drawings

The originally filed drawings were objected to for not including reference signs “40” and “42” from the Description Of Specific Embodiments on page 7, line 16 of the original filing for the present application. Replacement drawings are submitted herewith that include reference signs “40” and “42” on FIG. 5 of drawing sheet 5/8. No new matter has been added. Applicants’ request that the objection to the drawings be withdrawn.

Rejection to the Specification

The specification was objected to for failing to provide proper antecedent basis for claims 5-10. As discussed below, claims 5-10 have been amended, rendering this objection moot. Applicants’ request that the objection to the specification be withdrawn.

Indefiniteness Rejection

Claims 5-10 were rejected under 35 U.S.C. 112 ¶2 as being indefinite. Specifically, the Office Action alleges that it is unclear as to what the term “kit” means. Amended claims 5-10 clarify the present invention by replacing the term “kit” with the phrase “group of components”. Accordingly, the amendments to claims 5-10 overcome the rejection and place the claims in a condition for allowance.

Anticipation Rejection Based on Fogelman

In the June 29, 2007 non-final Office action, claims 1-5, 9-11 and 15-17 were rejected under 35 U.S.C. § 102(b) as being anticipated by Fogelman. These rejections are respectfully traversed.

Fogelman discloses a universal video game cabinet having a means for providing quick change of the game and the identifying display information. (See column 1, lines 8-10). Fogelman further discloses plug-in cards or program chips to quickly change an electronic game by opening a door to the electronics and removing prior game chips or cards and replacing them with new cards or chips. (See column 2, lines 64-68). Fogelman also provides for replacing display panels around a video monitor and an information panel (typically carrying the name and/or logo) positioned at the forwardmost portion of the overhang. (See FIGs. 1 and 6; column 3, lines 1-5; column 4, lines 14-20). Fogelman's information panel can be removed simply by loosening screws, letting the panel drop down, and replacing the panel with a suitable display panel. (See FIGs. 1 and 6; column 4, lines 18-22). It is noteworthy that Fogelman does not disclose that at least a portion of the second display elements have a different shape than the first display elements and that the display elements include a side panel for the top box display.

Independent Claim 1

Fogelman does not disclose or suggest *inter alia* (i) installing a plurality of second display elements on a substructure of a top box in place of a plurality of first display element, or (ii) that at least a portion of the second display elements have a different shape than the first display elements, as recited by amended claim 1. Furthermore, Fogelman does not disclose that the first display elements and the second display elements substantially enclose the front and sides of a top box, as further recited in amended claim 1. In contrast, Fogelman only discloses, for example, replacing display panels that are shown to be flat¹ and of the same size in all the figures. (See, e.g., FIGs. 1, 3, 6, 8 and 9; column 3, lines 54-61). In further contrast, Fogelman's disclosure is limited, for example, to an overhang having a single, flat information display panel

¹ In addition to only showing flat panels, Fogelman's use of the term "panel" suggests the disclosure is limited to flat objects. See <http://www.m-w.com/dictionary/panel> (defining the term panel as "a thin usually rectangular board set in a frame (as in a door)" and "a flat usually rectangular piece of construction material...made to form part of a surface") (last visited on October 28, 2007).

and an overhang and groove suggestive of only being able to replace the single panel with one of a similar shape. (*See, e.g.*, FIGs. 1, 3, 6 and 9; column 4, lines 14-27). Additionally, Fogelman's disclosure is limited to the replacement of display panels located on the front of a game cabinet. (*See, e.g.*, FIGs. 1, 3, 6 and 9). Accordingly, Fogelman does not disclose or suggest every element of amended claim 1.

For at least the reasons cited herein, amended claim 1 is not anticipated by Fogelman, and thus, should be in a condition for allowance.

Independent Claims 5 and 11

Fogelman does not disclose or suggest *inter alia* that (i) at least a portion of the second display elements have a different shape than the first display elements, or (ii) at least a portion of the first display elements and the second display elements include a side panel for the top box display, as recited by amended claims 5 and 11. In contrast, Fogelman only discloses, for example, replacing display panels that are shown to be flat and of the same size in all the figures. (*See, e.g.*, FIGs. 1, 3, 6, 8 and 9; column 3, lines 54-61). In further contrast, Fogelman's disclosure is limited, for example, to an overhang having a single, flat information display panel and an overhang and groove suggestive of only being able to replace the single panel with one of a similar shape. (*See, e.g.*, FIGs. 1, 3, 6 and 9; column 4, lines 14-27). Additionally, Fogelman's disclosure is limited to the replacement of display panels located on the front of a game cabinet. (*See, e.g.*, FIGs. 1, 3, 6 and 9). Accordingly, Fogelman does not disclose or suggest every element of amended claims 5 and 11.

For at least the reasons cited herein, amended claims 5 and 11 are not anticipated by Fogelman, and thus, should be in a condition for allowance.

Dependent Claims 2-4, 9-10 and 15-16

Amended claims 2-4, 9-10 and 15-16 depend directly from amended claim 1, 5 and 11, respectively, and are not anticipated by Fogelman for at least the reasons discussed above in connection with claims 1, 5 and/or 11. Accordingly, claims 2-4, 9-10 and 15-16 are in a condition for allowance.

Furthermore, in contrast to claims 3, 9 and 15 and any suggestions in the Office action to the contrary, Fogelman's disclosure is limited, for example, to a single display panel on an overhang, and thus, does not disclose installing display elements on the substructure of a top box, such as sculptures, video displays, and mechanical displays, as recited in amended claim 3, 9 and 15. In addition, the Office action suggests that Fogelman discloses "side facing artwork" in anticipation of claims 4, 10 and 16. (Office action, p. 4). However, under the law of anticipation, "[f]or a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. *Diversitech Corp. v. Century Steps, Inc.*, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988) (emphasis added). While Fogelman does disclose side panels for the overall gaming cabinet, Fogelman does not disclose side facing artwork panels for a top box, as recited in amended claims 4, 10 and 16. Rather, Fogelman's disclosure is limited to front facing display panels. (See, e.g., FIGs. 1, 3, 6 and 9). Accordingly, every element of the claimed invention has not been identically shown in the Fogelman reference.

For at least the reasons cited herein, amended claims 2-4, 9-10 and 15-16 are not anticipated by Fogelman, and thus, should be in a condition for allowance.

Independent Claim 17

Fogelman does not disclose or suggest *inter alia* that (i) at least a portion of the display elements between the first and second games have different shapes, or (ii) at least a portion of the display elements include side panels for the top box, as recited by amended claim 17. In contrast, Fogelman only discloses, for example, replacing display panels that are shown to be flat and of the same size in all the figures. (See, e.g., FIGs. 1, 3, 6, 8 and 9; column 3, lines 54-61). In further contrast, Fogelman's disclosure is limited, for example, to an overhang having a single, flat information display panel and an overhang and groove suggestive of only being able to replace the single panel with one of a similar shape. (See, e.g., FIGs. 1, 3, 6 and 9; column 4, lines 14-27). Additionally, Fogelman's disclosure is limited to the replacement of display panels located on the front of a game cabinet. (See, e.g., FIGs. 1, 3, 6 and 9). Accordingly, Fogelman does not disclose or suggest every element of amended claim 17.

For at least the reasons cited herein, amended claim 17 is not anticipated by Fogelman, and thus, should be in a condition for allowance.

**Obviousness Rejection Based on Fogelman
in view of Seelig**

In the June 29, 2007 non-final Office action, claims 6-8 and 12-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fogelman in view of Seelig. These rejections are respectfully traversed.

Seelig discloses a gaming device base having a wire chase for storing electrical wires. (See FIG. 5; ¶¶ [0013], [0017] and [0054]). Seelig further discloses a vertical wire partition and a vertical member in the gaming device base that define a gap in between them through which electrical wires run through a wire chase. (See ¶ [0054]). It is noteworthy that Seelig only discloses a wire chase for the base of a gaming device and does not disclose a wire chase for a standardized substructure of a top box of a gaming machine, as recited in claims 6-8 and 12-14.

Furthermore, claims 6-8 and 12-14 depend either directly or indirectly from independent claims 5 and 11, respectively. As discussed above, since all the elements of amended claims 5 and 11 cannot be found in Fogelman, a *prima facie* case of obviousness has not been established. Seelig does not overcome the deficiencies discussed above for claims 5 and 11.

For at least these reasons, neither of Fogelman and Seelig, either alone or in combination, discloses or suggests pending dependent claims 6-8 and 12-14.

Examiner's Reference to Hedrick

As discussed above, the Examiners referred during the telephone interview on October 4, 2007, to a reference, Hedrick, as describing a gaming machine having a top box. (See Hedrick column 3, line 52-56). Hedrick is representative of old top box designs described, for example, in paragraph [0007] of the present application, as requiring a complete replacement when converting a gaming machine to a newer game. Hedrick describes its top box as preferably being "a modular portion of the gaming machine that can be removed and reinstalled as

necessary.” (column 6, lines 39-42). Thus, Hedrick’s disclosure does not overcome the deficiencies discussed above for Fogelman and Seelig.

New Claims 18 and 19

New claims 18 and 19 depend from amended claims 1 and 17, which as discussed above, are not disclosed in Fogelman. Furthermore, Fogelman appears to be limited to teaching brackets or support frames located toward the front of the gaming machine to which a display panel can be attached, rather than having at least a portion of a standardized substructure toward the back of a top box, as recited in new claims 18 and 19. (*See, e.g.*, FIGs. 1, 3 and 6). The newly cited Hedrick reference, does not overcome the deficiencies of Fogelman. Hedrick’s disclosure with respect to top boxes appears limited to describing the physical structure of a top box display in general terms without any detailed description of how the top box display is supported. (*See* FIGs. 1-4). For at least the reasons, new claims 18 and 19 should be allowed.

CONCLUSION

Applicants submit that claims 1-19 are in condition for allowance and action toward that is respectfully requested. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at (312) 425-8552.

It is believed that no additional fees are due other than the fee for one-month extension; however, should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from the Nixon Peabody LLP Deposit Account No. 50-4181, Order No. 247079-000231USPT.

Respectfully submitted,

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